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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,605	06/30/2000	Kia Silverbrook	NPA065US	8541

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,605

Applicant(s)

SILVERBROOK ET AL.

Examiner

Marc R Filipczyk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/13/03 and RCE of 9/9/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final. *
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-29 and 34-114 is/are rejected.
- 7) ☒ Claim(s) 1-3, 8-29 and 34-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Action is responsive to Applicant's RCE request filed on September 9, 2003 and amendment submitted on July 13, 2003 (paper # 8 and 10).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 9 2003 has been entered.

Claims 1-3, 8-29 and 34-114 remain for examination and claims 4-7 and 30-33 also remain cancelled.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 1-3, 8-29 and 34-45 are objected to because of the following informalities:

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Regarding claims 1 and 27, the segment, "form including printed coded data indicative of an identity of the form and of at least one form reference point of the form" is not descriptive.

How does the coded data indicate form reference point?

Regarding claims 2, 3, 8-26, 28, 29 and 34-45 depend from 1 and 27 respectively and therefore contain the deficiencies of those claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-18, 22-25, 27-29, 34-41, 43, 44, 46-57, 61-64, 66-74, 76, 77, 79-92, 96-99, 101-110, 112 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Suda et al (U.S. Patent No. 6,157,465).

Regarding claims 27, 29, 39, 44, 61, 66, 72, 73, 77, 101, 109 and 113, Escallon discloses a method and system for enabling access to travel services, the system including (see title) a form containing information relating to a travel service transaction, the form including coded data indicative of an identity of the form and of at least one reference point of the form, the method including: (fig. 1, 140 and, col. 5, lines 49-54, Escalloon)

(Note: reference point of a form refers to any location on the form)

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a computer system for receiving indicating data (fig. 1, block 200, Escallon) from a sensing device (fig. 1, 100) for identifying at least one parameter relating to the travel service transaction, the indicating data being indicative of the identity of the form and a position of the sensing device relative to the form (fig. 1, 110), the sensing device sensing the indicative data using at least some of the coded data (fig. 1, 110, Escallon); and

identifying in the computer system and from the indicating data, at least one parameter relating to the travel service transaction (fig. 1, block 142 Escallon), but does not teach the sensing device is a handheld device including a marking nib.

However, Suda discloses a system for transferring jobs between processing units for which he uses an (e-pen) marking device (fig. 6, 605, Suda). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used an e-pen in Escallon system as used in Suda system to enter data into forms without using a keyboard. The motivation for one of ordinary skill in the art to use an e-pen would have been the convenience and flexibility of entering data to fill out forms without the use of a keyboard.

Regarding claim 28, Escallon/Suda disclose one parameter relating to the travel service transaction is associated with at least one zone of the form (col. 5, lines 49-57, Escallon).

Regarding claims 34, 67 and 104, Escallon/Suda disclose at least one parameter of the travel service transaction is selected from a group comprising an action parameter of the travel services transaction (fig. 3, blocks 301, 320, 330, Escallon).

(Note: fulfilling transaction requests)

Regarding claims 35-38, 68-71 and 105-108, Escallon/Suda disclose multiple parameters of travel service transactions (see col. 3, lines 1-14, Escallon).

Regarding claims 41, 74 and 110, Escallon/Suda disclose all of the claimed subject matter as discussed above with respect to claim 27 including improvements over more traditional methods such as the use of printed media (see col. 1, lines 39-47, Escallon).

Regarding claims 43, 76 and 112, Escallon/Suda disclose a database for keeping a retrievable record of each form generated, each form being retrievable by using its identity as included in its coded data (col. 4, lines 26-40, Escallon).

Regarding method claims 1-3, 8-18, 22-25, 46-57, 62-64, 79-92 and 96-99 contain same subject matter as the system claims respectively and therefore are rejected on the same basis under 35 U.S.C. 103(a) as the claims above in combination over Escallon (U.S. Patent No. 5,799,157) in view of Suda et al (U.S. Patent No. 6,157,465).

Claims 19-21, 26, 42, 45, 58-60, 65, 75, 78, 93-95, 100, 111 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Suda et al (U.S. Patent No. 6,157,465) further in view of Wilz Sr. et al (U.S. Patent No. 5,992,752).

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Regarding claims 19-21, 26, 42, 45, 58-60, 65, 75, 78, 93-95, 100, 111 and 114, Escallon/Suda disclose all of the claimed subject matter as discussed above with respect to claims 1, 27, 46, 66, 79, 101 and 114, but do not expressly teach printing forms.

However, Wilz discloses an internet based system for enabling information-related transactions over the internet (title, Wilz) in which printing of coded transactions takes place (fig. 1, item 39, Wilz). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to print part coded forms in Escallon/Suda system as done in Wilz by using a printer in conjunction with a computer. One of ordinary skill in the art would have been motivated to print forms to retain a physical copy of a transaction for record.

Response to Arguments

Applicant's arguments filed on July 13, 2003 along with an RCE request have been fully considered but they are not persuasive. The Applicant's arguments of the 7/13/2003 response and Examiners answers are listed below.

Argument: (page 20)

Escallon does not disclose a "form ... including printed coded data".

Response:

Examiner disagrees. Abstract, lines 12 and 13, Escallon discloses forms are coded. Examiner emphasizes that printed coded data on a form is equivalent to coded data on an electronic form.

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Argument: (page 20)

Escallon does not disclose any coded data which is "indicative of an identity of the form and of at least one reference point of the form":

Examiner disagrees. In the above response Escallon's coded forms are disclosed. Further, electronic forms contain coded data as the form's identifier: see fig. 1 of Escallon system, electronic book 100 keeps track of all the electronic forms 140. Last, reference point of a form refers to any location on the form.

Argument: (page 20)

Escallon does not disclose "a hand-held sensing device". Escallon's transaction management server is a large computer which could not be accurately described as a hand-held device.

Examiner disagrees. Escallon's transaction management server is a computer and not a hand-held device, and therefore a second prior art is used for the limit claiming a hand-held device.

Argument: (page 21)

Wilz does not disclose "printed coded data indicative of an identity of the form".

Response:

Examiner disagrees. Wilz system discloses a scanning device, programmable decoder, code string synthesizer with a code generator module and data transmission (fig. 1B3, Wilz) which scan and process documents (fig. 1, Wilz). Thus, Wilz alone anticipates coded forms.

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Examiner further notes that Wilz was cited to demonstrate the state of art of printing (Escallon/Suda) coded forms at the time the invention was made.

Argument: (page 21)

Neither citation discloses a sensing device which generates such indicating data using printed coded data.

Examiner disagrees. Please refer to the Escallon in view of Suda rejections. Examiner also notes that most conventional hand-held scanners read on Applicant's claimed limitations.

Attorney's comment: (page 22)

It was clear from the context of the present specification that forms were forms with printed coded data on them, and that the sensing device was a hand-held device, thus Examiner should have searched for prior art relating such.

In response to Applicant's comment on searching, it is noted that even though the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner appreciates any "clear" context from the specification that the Applicant feels is vital to the invention be clearly incorporated in the claims.

Conclusion

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156. The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MF
February 10, 2004



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